

CUSTOMER NO.: 24498
 Serial No.: 09/445,132
 Final Office Action dated: October 3, 2005
 Response dated: December 7, 2005

PATENT
 RCA 88,637

Remarks/Arguments

Reconsideration of this application is requested. Claims 1-5 and 7-22 are pending. Claims 21 and 22 have been amended without prejudice herein. Claims 1-5 and 11-22 have been cancelled without prejudice herein.

Allowed Claims and Claims Including Allowable Subject Matter

Applicants acknowledge that Claim 10 has been allowed. The October 3, 2005 Office action indicates the subject matter defined in Claims 7-9, 21 and 22 are not covered by the cited prior art.

35 U.S.C. 112, First Paragraph Rejections

Claims 7-9 and 21-22 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse these rejections for at least the following reasons.

The Office action argues "the specification only enables establishing a communications channel between a first and second electronic devices in response to the authentication of the second device after the first device sends confirmation of the authentication back to the second device." 10/3/2005 Office action, page 6, lines 5-8.

As an initial matter, Applicants submit it is improper to read an order onto the steps recited in the present claims in the first place. See, e.g., *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (Although the specification discussed only a single embodiment, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). For purposes of completeness, Applicants note the disclosure as originally filed fully supports the concept of establishing a communications channel without a confirmation at all, and thus does not explicitly or inherently require a confirmation prior to establishing a communications channel. (See, e.g., original Claim 1).

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Second, while the detailed exemplary embodiment of page 11 discloses process Step 180 (confirmation) precedes process Step 190 (establishing a communications channel), Applicants submit the claimed invention is not limited to that specific embodiment, as suggested in the present Office action. *"That claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims."* *Raytheon Co. v. Roper Corp.* 724 F2d 951, 957. That is, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment. *See, e.g., E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (*"Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims 'in view of the specification' without unnecessarily importing limitations from the specification into the claims."*).

However, for purposes of expediting prosecution of the present application, Applicants have amended Claims 21 and 22 without prejudice in accordance with Examiner's requested format. However, for the reasons discussed herein, Applicants submit the present amendment is not a narrowing amendment. Reconsideration and removal of this 35 USC 112 rejection of Claims 21, 22 and 7-9 is requested.

35 U.S.C. 112, Second Paragraph Rejections

Claims 7-9 and 21-22 stand rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements. Applicants traverse these rejections for at least the following reasons.

The Office action argues, "[t]he omitted elements are: encrypting the first message data using the second public key related to the second devices second private key to generate a second encrypted message."

First, Applicants note MPEP §2172.01 does not support the present rejections pursuant to 35 U.S.C. 112, second paragraph. MPEP §2172.01 states that a claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112,

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first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Furthermore, as discussed above, the claimed invention need not be limited to the specific exemplary embodiment referenced by the Examiner, as suggested in the present Office action. *"That claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims."* *Raytheon Co. v. Roper Corp.* 724 F.2d 951, 957. Applicants note neither Claim 21 nor Claim 22 recites, "confirming the authentication" relied upon in the Office action. Moreover, the disclosure as originally filed fully supports the concept of establishing a communications channel without a confirmation at all, and thus does not explicitly or inherently require a confirmation. *See, e.g., original Claim 1.*

Accordingly, encrypting the first message data using a second public key related to the second device private key to enable a confirmation is not essential to the invention. Nevertheless, solely for purposes expediting prosecution of the present application, and subject to Applicants' right to seek further prosecution of claims reciting a second public key relating to the second device second private key, Applicants have amended Claims 21 and 22 consistently with the Examiner's recommendation.

Accordingly, Applicants respectfully request reconsideration and removal of these rejections.

35 U.S.C. 103(a) Rejections

Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier (select portions of "Applied Cryptography", 2nd Ed.). Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Ohashi (United States Patent No. 5,761,309). Claims 12-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Ohashi, and further in view of Force (United States Patent No. 5,533,123).

Solely for purposes of expediting prosecution of the present application, without prejudice, and subject to Applicants' right to reintroduce these, and/or related, claims in this or a related Application, Applicants have cancelled Claims 1-5 and 11-20 herein.

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Having fully addressed the Examiner's rejections it is believed that, in view of the preceding remarks, this application stands in condition for allowance.

Reconsideration and allowance of this application is respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicants' attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled.

It is our understanding that there is no fee for the filing of this response; however, if, in fact, a fee is due, please charge the applicable fee to Deposit Account No. 07-0832.

Respectfully submitted,
Ahmet Mursit Eskicioglu et al.

By: 
Paul P. Kiel
Attorney for Applicants
Registration No. 40,677
(609) 734-6815

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Patent Operations
Thomson Licensing Inc.
P.O. Box 5312
Princeton, NJ 08543-5312

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